REMARKS

In view of the Office Action mailed 4/14/10, Applicant respectfully traverses the rejections as follows:

THE SECTION 112 REJECTION

Claim was rejected as not complying with the description requirement. Applicant has restored the claim to its prior language and respectfully traverses the rejection as the specification on pages 9-11 teaches that the computer performs the for each file, under programmatic control:

determining an application identifier for the file;

searching the patent office computer and determining new docket item(s) not present in a local database on the local computer;

downloading one or more file wrapper documents associated with the new docket item(s) from the patent office computer to the local database; and

automatically adding a docket entry with a deadline for each new docket item.

Relevant section of the specification on pages 9-11 are reproduced below:

Certain embodiments of Fig. 1B rely on the availability of the patent office computer over a network. To minimize uncertainty arising from network issues, items or documents indexed in the file wrapper are mirrored at a local computer in another embodiment. The mirrored items or documents form a digital filing system that replaces or supplements conventional paper-based files.

Additionally, the digital filing system on the local computer maintains copies of documents filed with the patent office but had not been processed to the point where the document(s) show up in the file wrapper index and images of the document(s) become available on line. For example, if the patent document (e.g., a patent application) is to be submitted electronically, the system forwards the patent document to a patent office computer over internet using a protocol previously determined by the patent office system to be acceptable for filing such documents. Generally such a protocol includes the patent office system generating a confirmation of receipt after successfully receiving the application. When the patent document is a new patent application the confirmation of receipt may include, for example, information denoting the filing date and serial number (or application number) assigned to the application. Additionally, after matching up with the file wrapper index, the copies of the filed documents can be archived to save disk space since the patent office already has one copy.

When the digital filing system receives the confirmation of receipt, it automatically enters the assigned filing date of the application into a database along with other identification information such as the application's application number or serial number. The digital filing system also saves a copy of the application as filed for proof of transmission and/or archival purposes. In this manner, a single action by the client (e.g., clicking on a "submit patent application" icon) both files the patent application and enters docketing information that can be subsequently used to create future reminder messages to maintain or pursue protection for the ideas and concepts disclosed in the patent application. These reminder messages can then later be generated by system and transmitted to appropriate client systems as described above.

In one embodiment, the filing system displays the stored files in a digital tri-fold file folder. In one implementation, communications between the client and attorney on the left side of a folder, papers filed in or received from the Patent Office in the center portion of the file and miscellaneous other papers (e.g., copies of the application as filed and/or figures) on the right side of the file.

Since new communications are periodically issued by the patent office, the mirrored files at the local computer need to be periodically synchronized. In one embodiment, the process of Fig. 1C maintains digital patent application files as follows:

Login to the patent office computer (11)

For each docket item:

Determine application identifier for the docket item (12)

Search patent office computer and retrieve index for application identifier (14)

From index, determine new docket item(s) not present in a local database (16)

Download files associated with newly identified docket items from patent office computer to local database (18):

Retrieve each page image of the docket item from the patent office computer (20)

Combine page image(s), compress and format as a PDF document (22)

Optionally OCR the image to generate text searchable PDF document (24)

The document generated above may contain embedded links to other documents. For instance, an Office Action can cite to a number of prior art references. If the references are patents or documents that are digitally available, the embedded links can be clicked to bring up the reference for review. In another example, an Information Disclosure Statement (IDS) can reference a number of patents and prior art whose links can be embedded in the document. When clicked, the cited patents/prior art can be displayed in a window for user review.

The foregoing clearly teaches that the computer does the work and not a person. Withdrawal of the rejection is requested.

As to claims 19-20, Applicant has amended the claim back to the condition as filed. Withdrawal of the rejection is requested.

THE SECTION 102 REJECTIONS

Claimns 19-20 and 22 were previously rejected as unpatentable over Rivette (20030046307). The Office Action also previously rejected the claims under Section 112. However, the term is well known to those skilled in the art. For example, at the Patent Cooperation Treaty's web site http://www.wipo.int/sme/en/documents/ freedom_to_operate.html

Strategies for Obtaining Freedom to Operate

An FTO analysis based on the search of patent literature is in many ways just the first step. If the patent search reveals that there are one or more patents that limit your freedom to operate, your company will have to decide how to proceed. Assuming that the blocking patent(s) are valid, some of the most common strategies for having freedom to operate are the following:

- **Purchase the patent or in-licensing**. Licensing implies obtaining a written authorization from the patent holder to use the patented technology for specified acts, in specified markets and for a specified period of time. The convenience of such an agreement will depend largely on the terms and conditions of the proposed license. While there is a risk of a potential loss of autonomy determined by the terms and conditions of the agreement and the patent holder will require a lump-sum and/or periodic royalty payments, it may also be the simplest way of clearing the grounds for the commercialization of your new technology or product.

- **Cross-licensing**. Cross-licensing is when two companies exchange licenses in order to be able to use certain patents owned by the other party. This is the case of the example mentioned at the beginning of this article about the three pharmaceutical companies. Cross-licensing requires that your company has a well-protected patent portfolio that is of value to potential licensing partners.

- **Inventing around**. A third alternative for your company is to invent around the invention. This implies steering research or making changes to the product or process in order to avoid infringing on the patent(s) owned by others. For example, if your freedom to operate is limited by a process patent, then your company may be able to develop an alternative process

for arriving at the same or similar end result and thus be able to commercialize the invention without the need to pay a licensing fee to someone else.

- **Patent pools**. A patent pool is one mechanism by which two or more companies practicing related technologies put their patents in a pool to establish a clearinghouse for patent rights. A well-known example of a patent pool is that formed by Sony, Philips and Pioneer for inventions that are essential to comply with certain DVD-Video and DVD-ROM standard specifications.

Thus the determining of IPs required to provide freedom to operate can include purchasing of the patents or cross licensing of the patents or inventing around as noted by the WIPO/PCT discussion. Here, Rivette fails to teach determining IPs required to provide freedom to operate. Withdrawal of the rejection is requested.

THE SECTION 103 REJECTIONS

Claims 1-12 and 14-17 were rejected under Section 103(a) over PAIR and Granger 20020161733. Applicant respectfully traverses the rejection.

The Office Action notes that Grainger I's [42] and [120] shows the downloading one or more file wrapper documents associated with the new docket item(s) from the patent office computer to the local database.

Further, Grainger I fails to show automatically adding a docket entry with a deadline for each new docket item and displaying the deadline based on a downloaded file wrapper document.

For the above three separate reasons, Grainger cannot anticipate claims 1 and those dependent therefrom. Moreover, Grainger fails to show the specifics of the dependent claims 2-12 and 14-17, and this is another basis of traversing the Section 102 rejection. Applicant traverses the Office Action determination that words in the claims with specific meaning such as mail-room date and document description as "non-functional descriptive material." TO the contrary, these words are specific items that are

to be accorded weight and can't simply be ignored. Withdrawal of the rejection on these claims is respectfully requested.

Claims 19-22 were rejected over Grainger 2. However, Applicant has read Grainger 2 carefully and fails to find searching one or more databases on a computer for one or more relevant IPs to an owner of a predetermined IP; performing a network analysis on the relevant IPs; and determining and displaying IPs infringed by the owner of the predetermined IP. Withdrawal of the rejection on claim 19 and dependent claims 20-22 is respectfully requested.

Claims 22-24 were rejected under Section 102 as anticipated by PAIR. However, PAIR does not retrieve file wrapper history for a plurality of cases recited in a computer readable list. Further, PAIR does not receive an application serial number conforming to a format aa/bbbbbb; and determine a published patent application matching the bbbbbb. Rather, Applicant believes that PAIR uses both the aa code and the bbbbbb code to locate a document. Further, PAIR does not automatically downloading file wrapper history for each case in the list as one or more PDF documents to a computer.

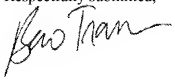
In the invention, the file history download for a number of cases is done automatically by the computer programmed in accordance with the invention without manual operator intervention. The systems of claim 22-23 programmatically automates this task for the user so that he/she can retrieve information on specified cases without having to click on buttons in each case to download. This enables seamless checking of the user's cases and can be done automatically without the user even being present. Hence, the system as claimed differs from PAIR, which is intended for manual human operation.

Withdrawal of the rejection is respectfully requested.

CONCLUSION

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 408-528-7490.

Respectfully submitted,



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